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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/073,877	05/07/98	FORD	L LN.010

021967
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QM31/0608

EXAMINER

HIRSCH, P

ART UNIT

PAPER NUMBER

3732

24

DATE MAILED: 06/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/073,877

Applicant(s)
Ford et al

Examiner
Paul Hirsch

Art Unit
3732



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 28, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-51 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 23 20) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 27-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Senter et al in view of Heggeness et al, Wagner et al, Cottle, Gross et al and McKay. While Senter et al teaches an implant of included protrusions it would be obvious in view of both the teachings of Senter et al and Heggeness et al of known allografts to form a prosthesis such as taught by Senter et al with the known and conventional shapes of spinal prosthesis. Heggeness et al teaches (col. 1, lines 43-57 for example) that allografts can be produced in various sizes and shapes. The inclusion of various shaped protrusions such as ridges, pyramids, points of known construction in bone prosthesis such as taught by Wagner et al, Cottle, McKay and Gross et al is considered a matter of obvious design choice to one of ordinary skill in the art as well as specific dimensioning. The method steps of claims 49-51 would be obvious in view of the references applied.

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Response to Arguments


3. Applicant's arguments filed November 1, 1999 and May 19, 2000 have been fully reconsidered but they are not persuasive. Applicant in their remarks have stated in their argument that the references just do not teach or make obvious their invention of a bone allograft of various shapes as recited by the claims. This is not found to be persuasive since as stated in the rejection both Senter et al (col. 2, lines 3-23) and Heggeness et al (col. 1, lines 44-57) teach as part of the known prior art allografts (which must have some shape) of an inherent shape with Heggeness et al teaching that the allografts may be produced in a variety of shapes and sizes. Accordingly, it follows that the known shapes of similar implants such as shown by Wagner et al, Cottle, McKay and Gross et al would be produced and obvious and/or known to a person of ordinary skill in the art. Accordingly, it is believed that that the apparatus and structure as broadly recited by the claims would be obvious from the teachings of the references applied.

In response to applicant's argument that there is no suggestion to combine the references which is inclusive of the argument of teaching away, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958

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F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as stated above both Senter et al and Heggeness et al teach prior art of known bone allograft with Senter et al showing an implant 50 inclusive of what may be termed protrusions 66,68 in the broadest sense and Heggeness et al stating that the allografts may be made in various shapes and sizes. Accordingly, the combination of these teachings with known prior art shapes is believed obvious to a person of ordinary skill in the art, and further in view of Heggeness et al the specific shape is one of obvious design choice.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Paul Hirsch whose telephone number is (703) 308-2697.



Paul J. Hirsch
Primary Examiner

pjh

April 30, 2001